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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,632	05/23/2001	Kerry McLellan	KNK-3.2.001/3705	1720
1059	7590	05/18/2005	EXAMINER	
BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 05/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,632

Applicant(s)

MCLELLAN, KERRY

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-36 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-14, 16, 17, 19, 33, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Shannon (US 2001/0045449).

3. With respect to Claims 1 and 35: Shannon discloses the use of an apparatus for storing a parcel comprising:

- a. A storage locker (Figures 1, 3-6),
- b. A lock coupled to locker (50)
- c. A delivery access key for accessing storage locker (130)
- d. The key configured to change after use (page 2, paragraph 0012). Shannon discloses that once the key for delivery used the key is deactivated (Paragraph 0012), and a similar temporary access code can be used by the recipient (or consumer). It is the examiner's position that the word "similar" inherently means that there is something different about them. Therefore due to the fact that Shannon discloses that the delivery access code is deactivated after use, and then the recipient then uses a similar temporary access code, that the two codes are in fact different.

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4. With respect to Claims 2 and 35: Shannon discloses the key being synchronized with a key at a location remote from said lock (synchronized between delivery person and receiver, page 5, paragraph 0038).
5. With respect to Claim 3: Shannon discloses a control unit located at remote location, external to device (page 4, paragraph 0036).
6. With respect to Claims 5-9: See Page 4, paragraphs 0034 and 0037.
7. With respect to Claim 10: See Page 3, paragraph 0027.
8. With respect to Claims 11-14: Shannon discloses the locker comprising a plurality of openings or compartments, and different size shelves, all accessed by the same overall door and code (page 3, paragraph 0027).
9. With respect to Claim 16: Shannon discloses a method of delivering a parcel comprising the steps of placing parcel in locker, locking storage locker, where locker is accessed by key, and changing key after being used (page 5, paragraphs 0039, 0041 and 0042).
10. With respect to Claims 17 and 33: See Page 5, paragraph 0038.
11. With respect to Claim 19: See Page 5, paragraph 0036.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 16, 17, and 19-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie et al. (6,344,796).

14. With respect to Claim 16: Ogilvie discloses the use of a method of delivering a parcel comprising the steps of:

- a. Placing parcel in locker (column 4, lines 1-4),
- b. Locking locker (column 4, lines 4-5),
- c. Wherein storage locker is accessible with a key (column 4, lines 12-20), and
- d. Changing said key subsequent to use (column 4 lines 20-23).

15. Ogilvie, however fails to disclose the step of first unlocking the actual locker before placing the parcel in the locker. It is old and well known in the art that when a parcel is delivered to a secure location that the container is first unlocked before placing the item into the container. For example in group mailboxes, when a post made delivers mail to an apartment, one key is used to open the boxes, the mail is placed inside and the individual keys of the residents are used to open the boxes. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogilvie, to first unlock the boxes, then lock them back up, for security and privacy purposes.

16. Oglivie also fails to disclose the depot is selected by the consumer. This step is considered to be non-functional descriptive data and is not functionally involved in the steps recited. The fact that the consumer chooses the depot, as opposed to a server selecting a depot, is not functionally related to the claimed invention. The steps of unlocking the locker would be performed the same regardless of who selected the depot. Thus this descriptive material will not

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distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

17. With respect to Claim 17: See Claim 1.
18. With respect to Claim 19: See Column 4, lines 45-53 and Claims 11 and 12.
19. With respect to Claim 20-25 and 30-33: See column 4, lines 24-53.
20. With respect to Claim 26: See Claim 15.
21. With respect to Claims 28 and 29: See Column 4, lines 54-67 and column 5, lines 22-30.
22. With respect to Claim 34: Ogilvie discloses a method and means for delivering a parcel comprising the steps:
 - e. Providing parcel and depot selection to delivery agent (carrier or shipper) (column 3, lines 50-52),
 - f. Delivering parcel to depot (column 3, lines 59-65),
 - g. Delivery agent selecting locker and placing parcel in locker (column 4, lines 1-5),
 - h. Providing parcel ID and locker ID to central system (column 4, lines 6-23),
 - i. Central system providing customer with parcel ID and locker ID (column 4, lines 24-44),
 - j. Customer using key to retrieve parcel from locker (column 4, lines 45-67).
23. With respect to Claims 38 and 39: See Column 4, lines 20-23, the lock is reset, and if the lock is reset after each use then the delivery item key must be reset, and therefore recalculated for the next use.

24. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie.

25. Ogilvie as disclosed for Claim 24 above, discloses using e-mail to send a message to the customer that the delivery is ready for pick-up (column 2, lines 50-67), but fails to disclose verifying that the customer received the e-mail. It is old and well known in the art that when an e-mail is received there is an option of a receipt. Therefore it is obvious to one having ordinary skill in the art that to add a read receipt onto the e-mail that is sent to customer, to make sure the customer received the message.

26. Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon in view of O'Connor (6,330,816).

27. Shannon, as disclosed above for Claims 1 and 16, discloses the use of a storage locker with either a mechanical or an electrical lock (Page 4, paragraph 0037), but fails to disclose the use of an electrical key, which accesses a mechanical key to open the lock box. O'Connor discloses a lock, that is mounted on a door in a closed position (see abstract), that contains a mechanical key that opens the door and is accessed using a keypad, or an electronic key (see figures 7-9 with corresponding detailed descriptions). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the storage locker of Shannon, to include the lock box with access to the mechanical key, as disclosed by O'Connor, in order to provide the benefit of enabling limited access to an unattended area which is a mechanical lock (See O'Connor column 1).

Response to Arguments

28. Applicant's arguments filed 8/10/04 have been fully considered but they are not persuasive.

29. With respect to applicant's arguments that Shannon does not disclose the use of two different keys: The examiner has modified the rejection to incorporate this newly added amendment. The examiner notes that the applicant has stated that the examiner admits Shannon does not disclose that the keys are different. The examiner, in the arguments, states that the applicant was arguing something that was not in the claims, the examiner did not state that Shannon does not disclose the keys are different, just that the claims don't necessarily state that they are different.

30. With respect to Applicant's arguments that Ogilvie does not disclose allowing a consumer to select a depot to which the parcel is delivered. The rejection above is modified to address this limitation. The applicant has argued that the consumer choosing the depot is essential, however, the steps of the claimed invention, merely recite unlocking the locker, and are drawn to how the storage locker is accessed. The fact that the a consumer chooses a depot, in which the locker that is being operated, is deemed to be not functionally related to the method steps of the claimed invention. The locker can be accessed and the keys change the same way, whether the depot, in which the locker is located, is chosen by the consumer or another person, such as a carrier.

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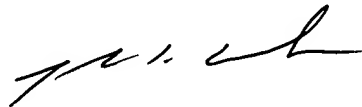
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811.

The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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